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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,652	04/21/2004	Gregory E. Upchurch	GEU00005-004	4919

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EXAMINER

LOVEL, KIMBERLY M

ART UNIT PAPER NUMBER

2167

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/828,652

Applicant(s)

UPCHURCH ET AL.

Examiner

Kimberly Lovel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Claims 1-12 are rejected.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 7-10 and 12** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claim 7** is directed towards an electronic data structure, which is considered to be software per se. Software is considered to represent non-statutory subject matter.

According to MPEP 2106:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

**Claims 2-6**, which are dependent on claim 1 fail to overcome the rejection and therefore are rejected on the same grounds as claim 1.

**Claim 12** is rejected under 35 U.S.C. 101 because the claimed invention is directed to a signal which is one example of non-statutory embodiments which improperly include network transmission lines (interpreted as wired and wireless transmission), wireless transmission media, signals propagating through space, radio waves, infrared signals, etc.

According to MPEP 2106:

There is always some form of physical transformation within a computer because a computer acts on signals and transforms them during its operation and changes the state of its components during the execution of a process. Even though such a physical transformation occurs within a computer, such activity is not determinative of whether the process is statutory because such transformation alone does not distinguish a statutory computer process from a nonstatutory computer process. What is determinative is not how the computer performs the process, but what the computer does to achieve a practical application. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036.

To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No 7,043,489 to Kelley (hereafter Kelley).**

**Referring to claim 1**, Kelley discloses the a method of analyzing court docket information to facilitate the use of said information comprising:

obtaining a court docket in electronic form [step 92: retrieve user's case folders]  
(see Fig 4);

identifying entries [documents] in the docket associated with a primary entry  
[case] [step 112: display docket entries] (see Fig 4);

inserting in the electronic form of the docket a table of associated entries [rows in the table] adjacent [below the heading Case 1 and the case description 218] the primary entry [case 1] (see Fig 10);

so that visual display of the electronic form of the court docket discloses to a human user the docket entries associated with the primary entry (see Fig 10).

**Referring to claim 2**, Kelley discloses the method as set forth in claim 1 further including identifying label [each individual title in column 222] in the table for each of the

associated docket entries [each row in the table represents an entry] (see column 13, lines 23-36 and Fig 10).

**Referring to claim 3**, Kelley discloses the method as set forth in claim 1 further including inserting links [number 220] in the table to the associated entries [each row in the table represents an entry] (see column 13, lines 33-45 - “ clicking on” one of the numbers 220 for the desired document displays the document in page 228).

**Referring to claim 4**, Kelley discloses the method as set forth in claim 1 wherein the court docket includes attorney identifying information [fields for Plaintiff’s Attorney and Defendant’s Attorney], further including the step of enabling suppression [“any of the exemplary fields can be used to associate a subject matter with each document, and the term ‘subject matter’ is intended to include any identifying information for a document – having the ability to include or thus not include a field is considered to represent enabling suppression of the fields Plaintiff’s Attorney and Defendant’s Attorney] (see column 7, lines 63-67) of said attorney identifying information [Plaintiff’s Attorney and Defendant’s Attorney].

**Referring to claim 5**, Kelley discloses the method as set forth in claim 1 wherein the associated entries [documents] are identified by use of a number code [Case/Docket #] (see Table 2, line 51) contained in the court docket information (when a case is added to the system, there is a field for the Case/Docket #; Table 1 shows where the documents have a field for case number and docket number).

**Referring to claim 6**, Kelley discloses the method as set forth in claim 1 wherein the table is inserted after the primary entry [Case 1] (see Fig 10 – the table for Case 1 is located below the heading Case 1).

**Referring to claim 7**, Kelley discloses an electronic data structure [central repository 17 for storing and managing litigation-related documents in a structured database 20] representing court docket information [litigation-related documents] comprising:

a computer memory having stored therein data representing docket entries [central repository 17 for storing and managing litigation-related documents in a structured database 20], said entries including at least one primary entry [case with a case number] (see Table 2 – a user can add a case and then add document to that particular case) and at least one associated entry [documents] associated with said primary entry [case] (see column 7, line 62 – column 8, line 24 – each document entry has a field for a case number which associates the document with the case [primary entry]) and at least one table of associated docket entries [each row in the table represents an entry] for at least one case (see Fig 10 – the figure displays the table of associated document entries for case 1).

**Referring to claim 8**, Kelley discloses the electronic data structure as set forth in claim 7 wherein the data representing said table includes data representing identifying labels [each individual title in column 222] for the associated docket entries [each row in the table represents an entry] (see column 13, lines 23-36 and Fig 10).

**Referring to claim 9**, Kelley discloses the electronic data structure as set forth in claim 7 wherein the data representing said table includes data representing links [number 220] to said associated docket entries [each row in the table represents an entry] (see column 13, lines 33-45 - “ clicking on” one of the numbers 220 for the desired document displays the document in page 228).

**Referring to claim 10**, Kelley discloses the electronic data structure as set forth in claim 7 wherein the data structure includes data representing a plurality of tables, each table corresponding to a unique primary docket entry [each individual case 210 represented by a case folder] and containing associated entries for said corresponding primary docket entry so that a plurality of primary docket entries [case folders] have tables corresponding thereto (see column 13, lines 19-36 – each individual case folder listed in Fig 9 has an associated table displayed by Fig 10; since there are a plurality of cases as shown in Fig 9, there are considered to be a plurality tables each being displayed in the manner of Fig 10).

**Referring to claim 11**, Kelley discloses the a method of using court docket information comprising:

obtaining a court docket in electronic form [step 92: retrieve user’s case folders] (see Fig 4);

identifying entries [documents] in the docket associated with a primary entry [case] [step 112: display docket entries] (see Fig 4);

inserting in the electronic form of the docket a table of associated entries [rows in the table] adjacent [below the heading Case 1 and the case description 218] the primary



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entry [case 1] corresponding thereto such that display of the electronic form of the court docket includes display of the table of associated entries (see Fig 10).

**Referring to claim 12**, Kelley discloses a computer data signal representing court docket information comprising:

a docket entry segment comprising court docket entries [rows in the table] for at least one case [Case 1] in electronic form (see Fig 10);

a table segment comprising a table identifying associated entries [rows in the table] for one of the docket entries [in this case the docket entry is the case] (see Fig 10);

said table segment being disposed such that upon display of the computer data signal said table segment is displayed adjacent [below the heading Case 1 and the case description 218] said one of the docket entries [Case 1] (see Fig 10).

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**Contact Information**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Lovel whose telephone number is (571) 272-2750. The examiner can normally be reached on 8:00 - 4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kimberly Lovel  
Examiner  
Art Unit 2167

29 September 2006  
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